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Practitioner's Docket No. 1001-053

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Michael J. Czaplicki et al.

Application No.: 09/847,252

Group No.: 1711

Filed: 05/02/2001

Examiner: Morton Foelak

For: TWO COMPONENT (EPOXY/AMINE) STRUCTURAL FOAM-IN-PLACE MATERIAL

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PETITIONS OFFICE

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Commissioner for Patents

P.O. Box 1450

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PETITION UNDER (37 C.F.R. § 1.313(c))
WITHDRAWAL FROM ISSUE—ISSUE FEE PAID

1. Applicants petition that the above identified application be withdrawn from issue. The issue fee was paid on April 14, 2003.
2. Reason for withdrawal from issue:

The reason applicant seeks withdrawal from issue of this application is:

a. After submitting a transmittal of payment of issue fee on April 14, 2003, and upon further review of the application prosecution history and U.S. Patent 4,923,902 to Wycech (hereinafter referred to as Wycech), Applicants have realized that (under certain possible interpretations of Applicants' allowed claims) assertions made in a Response and Amendment dated June 4, 2002 are not technically accurate. In an excess of caution, to avoid any potential for a claim that Applicants intended to mislead the Examiner in violation of 37 C.F.R. 1.56, Applicants submit this petition.

b. In particular, the following assertions were made regarding the references of record in the present application:

- i) "The references of record do not discuss nor does the Office Action mention the provision of both "an epoxy component" and an "amine

CERTIFICATION UNDER 37 C.F.R. §§ 1.8(a) and 1.10*

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Express Mail certification is optional.)

I hereby certify that, on the date shown below, this correspondence is being:

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X facsimile transmitted to the Patent and Trademark Office, (703) 308 -6916.

Date:

5.30.03

Signature

Shelley L. Eria

(type or print name of person certifying)

* Only the date of filing ("1.8") will be the date used in a patent term adjustment calculation, although the date on any certificate of mailing or transmission under "1.8 continues to be taken into account in determining timeliness. See "1.703(f). Consider "Express Mail Post Office to Addressee" ("1.10) or facsimile transmission ("1.8(d)) for the reply to be accorded the earliest possible filing date for patent term adjustment calculations.

component" as recited in claims 1 and 10 wherein each of the components include "a thixotropic filler" prior to their combination." and

- ii) "In addition to ignoring the above mention language, the Office Action also ignores the language in claims 1 and 10 suggesting the softening of a 'thermoplastic shell' by the 'amine-epoxy exotherm' for the purposes of expansion. None of the references of record disclose such expansion."

c. It has become apparent, however, upon subsequent review of the file, that Wycech discloses fillers that, although not particularly characterized by Wycech as "thixotropes", could qualify as thixotropes under a broad construction of Applicants claims, and may be present in both an epoxy resin and an amine curing agent prior to mixture thereof. Moreover, it has also become apparent that the mechanism for expansion disclosed by Wycech might be understood as being covered by "the softening of a 'thermoplastic shell' by the 'amine-epoxy exotherm' for the purposes of expansion."

d. Applicants continue to believe that the allowed claims patentably distinguish over that which is disclosed in Wycech. In particular, Applicants point out that independent claims 1, 10 and 20 each recite the "amine component" and the "epoxy component" in a "substantially liquid form" prior to combination thereof. In contrast, Applicants believe that Wycech appears to disclose forming a "first composition including ... a thermosetting resin" (e.g., an epoxy resin) into a "dough" and forming a "second composition including ... a curing agent" (e.g., an amine component) into a "dough" and combining the doughs to form an expandable material. (see col. 12, lines 15-45)

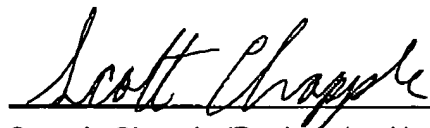
e. However, to still further comply with Applicants duties under 37 CFR 1.56, Applicants' attorney respectfully requests that this petition be granted under 37 CFR 1.313 (c)(2) and that the present application be remanded to the Examiner for further examination in accordance with the above. In this manner, Applicants can confirm that the Wycech reference, although of record for the present application, was thoroughly and independently examined by the Examiner. As set forth in the above paragraphs, such action is necessary based on a showing of good and sufficient reasons why withdrawal is necessary. The necessary fee set forth in 37 CFR 1.17(i) is enclosed herewith.

3. Petition fee (37 CFR § 1.17(i)):

Please charge Deposit Account 50-1097 in the amount of \$130.00. For any additional fees that may be due by the filing of this paper, please charge Deposit Account No. 50-1097.

A duplicate of this petition is attached.

Date: 5-30-03



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